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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/569,766	06/30/2006	Donald M. Crothers	GENOM032NP	4447
20995 7590 09/18/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER MARTINELL, JAMES				
ART UNIT		PAPER NUMBER		
1634				
NOTIFICATION DATE		DELIVERY MODE		
09/18/2008		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
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# Office Action Summary

## Application No.

10/569,766

## Applicant(s)

CROTHERS, DONALD M.

## Examiner

James Martinell

## Art Unit

1634

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☐ Claim(s) 1-63, 95-104, 129-136, 153 and 154 is/are pending in the application.
- 4a) Of the above claim(s) 49-63 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 13, 15, 16, 18, 19, 22-24, 26, 29-37, 39-42, 95-102, 129-134, 153 and 154 is/are rejected.
- 7) ☒ Claim(s) 10, 11, 14, 17, 20, 21, 25, 27, 28, 38, 43-48, 103, 104, 135 and 136 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/23/06 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-52)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 1/7/08

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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Claim 19, is objected to because of the following informalities: In claim 19, line 1, "equestering" is a typographical error. Appropriate correction is required.

Claims 49-63 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on August 7, 2008.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-9, 12, 13, 15, 16, 18, 19, 22-24, 26, 29-37, 39-42, 95-102, 129-134, 153, and 154 are rejected under 35 U.S.C. 102(a) as being clearly anticipated by Alsamdi et al (WO 02/077256 (October 3, 2002)). The reference teaches a nucleic acid molecular hybridization method that uses probes that contain two regions that bind to the target. Probes that bind to the target are circularized and amplified via rolling circle amplification. The probes of the reference also contain tags and may contain a promoter for the detection of RNA transcribed from the probe. For example, see Figure 1, the Abstract, page 4, line 32 through page 22, line 10, and claims 1-163. The reference uses a sequestering sequence to prevent rolling circle amplification in the absence of target sequences (for example, page 11, lines 1-25 and page 13, lines 7-29, and page 51, lines 10-26). The claims describe no more than the reference.

Claims 1-9, 12, 13, 15, 16, 18, 19, 22-24, 26, 29-37, 39-42, 95-102, 129-134, 153, and 154 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Alsamdi et al ( U.S. Patent Application Publication 20030022167).The reference teaches a nucleic acid molecular hybridization method that uses

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probes that contain two regions that bind to the target. Probes that bind to the target are circularized and amplified via rolling circle amplification. The probes of the reference also contain tags and may contain a promoter for the detection of RNA transcribed from the probe. For example, see Figure 1, the Abstract, paragraphs 0017-0065, and claims 1-163. The reference uses a sequestering sequence to prevent rolling circle amplification in the absence of target sequences (for example, paragraphs 0034, 0040, 0158, and 0159). The claims describe no more than the reference.

Claims 10, 11, 14, 17, 20, 21, 25, 27, 28, 38, 43-48, 103, 104, 135, and 136 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (571) 272-0719.

The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to [james.martinell@uspto.gov](mailto:james.martinell@uspto.gov). Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ram Shukla, can be reached on (571) 272-0735.

#### **OFFICIAL FAX NUMBER**

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any Official Communication to the USPTO should be faxed to this number.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to (571) 272-0547.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected.

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For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

/James Martinell/  
Primary Examiner  
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